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Date: 9-27-04

Himanshu S. Amin

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of:

Applicant(s): Curtis G. Wong, *et al.*

Examiner: Annan Q. Shang

Serial No: 09/650,481

Art Unit: 2614

Filing Date: August 29, 2000

Title: SYSTEM AND METHOD FOR IDENTIFYING AUDIO/VISUAL PROGRAMS
TO BE RECORDED

**Mail Stop Appeal Brief – Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450**

APPEAL BRIEF

Dear Sir:

Applicants submit this brief in connection with an appeal of the above-identified patent application. A credit card payment form is filed concurrently herewith in connection with all fees due regarding this appeal brief. In the event any additional fees may be due and/or are not covered by the credit card, the Commissioner is authorized to charge such fees to Deposit Account No. 50-1063 [MSFTP135US].

I. Real Party in Interest (37 C.F.R. §41.37(c)(1)(i))

The real party in interest in the present appeal is Microsoft Corporation, the assignee of the present application.

II. Related Appeals and Interferences (37 C.F.R. §41.37(c)(1)(ii))

Appellants, appellants' legal representative, and/or the assignee of the present application are not aware of any appeals or interferences which may be related to, will directly affect, or be directly affected by or have a bearing on the Board's decision in the pending appeal.

III. Status of Claims (37 C.F.R. §41.37(c)(1)(iii))

Claims 1-26 are pending in the application and stand rejected by the Examiner. The rejection of claims 1-26 is being appealed.

IV. Status of Amendments (37 C.F.R. §41.37(c)(1)(iv))

No claim amendments have been entered after the Final Office Action.

V. Summary of Claimed Subject Matter (37 C.F.R. §41.37(c)(1)(v))**A. Independent Claim 1**

Independent claim 1 and its corresponding dependent claims relate to systems for representing at least one audio and/or visual program. (*See e.g.*, Application at p. 4, lines 23-27). The systems employ a token having a schema that identifies a corresponding program so that a recording system receiving the token is programmable to record the program based on the token. (*See e.g.*, *Id.*). The token is transportable between at least two computers. (*See e.g.*, *Id.*). The token schema is a data structure that contains a plurality of fields for holding different types of data. (*See e.g.*, Application at p. 30, lines 27-30; pp.31-33; Fig. 8 element 450; and Table 1 at p. 34).

B. Independent Claim 8

Independent claim 8 and its corresponding dependent claims relate to electronic signals adapted to be transmitted between at least two computers. (See e.g., Application at p. 4, lines 28-29). The electronic signals have a message component that has an associated token having a schema. (See e.g., *Id.*). The token having a schema includes program criteria representing at least one corresponding audio and/or visual program. (See e.g., Application at p. 4, line 29 through p. 5, lines 1-2). The token schema is a data structure that contains a plurality of fields for holding different types of data. (See e.g., Application at p. 30, lines 27-30; pp.31-33; Fig. 8 element 450; and Table 1 at p. 34).

C. Independent Claim 16

Independent claim 16 and its corresponding dependent claims relate to computer-readable media having computer-executable components. (See e.g., Application at p. 5, lines 3-4). The computer-executable components include a first component that contains data representing a text email message, and a second component that is operatively associated with the first component. (See e.g., Application at p. 5, lines 4-6). The second component includes a token having a schema. (See e.g., Application at p. 5, lines 5-6). The token having a schema includes program criteria representing at least one corresponding audio and/or visual program. (See e.g., Application at p. 5, lines 6-7). The token schema is a data structure that contains a plurality of fields for holding different types of data. (See e.g., Application at p. 30, lines 27-30; pp.31-33; Fig. 8 element 450; and Table 1 at p. 34).

D. Independent Claim 20

Independent claim 20 and its corresponding dependent claims relate to a system for facilitating programming of an associated device. (See e.g., Application at p. 5, lines 9-10). The system includes means for providing a token having a schema. (See e.g., Application at p. 21, lines 2-6, p. 21, line 15 through p. 24, line 21, p. 27, lines 6-27, p. 28, line 3 through p. 30, line 26; p. 54, line 23 through p. 55, line 8; Fig. 3, elements 300, 310, Fig. 4, elements 396, 398, Fig. 5, element 400, Fig. 6, element 400, and Fig. 7, element 430). The token having a schema includes program criteria for identifying at

least one corresponding audio and/or visual program. (*See e.g.*, Application at p. 5, lines 10-12). The system includes means for extracting a token from a message received from another computer. (*See e.g.*, Application at p. 22, lines 7-8; p. 24, lines 1-2; p. 54, line 23 through p. 55, line 8; and Fig. 3, element 340). The token schema is a data structure that contains a plurality of fields for holding different types of data. (*See e.g.*, Application at p. 30, lines 27-30; pp.31-33; Fig. 8 element 450; and Table 1 at p. 34).

The means for extracting a token and the means for providing a token are identified as limitations subject to the provisions of 35 U.S.C. §112 ¶6. The corresponding structures are identified with reference to the specification and drawings in the parentheticals above corresponding to those claim limitations.

E. Independent Claim 22

Independent claim 22 and its corresponding dependent claims relate to a method for facilitating programming a recording system. (*See e.g.*, Application at p. 5, lines 15-16). The method includes receiving a message having at least one associated token. (*See e.g.*, Application at p. 5, lines 16-17). The method includes extracting a token from the message. (*See e.g.*, Application at p. 5, line 17). The token has a schema that includes program criteria representing a selected broadcast program. (*See e.g.*, Application at p. 5, lines 17-18). The token schema is a data structure that contains a plurality of fields for holding different types of data. (*See e.g.*, Application at p. 30, lines 27-30; pp.31-33; Fig. 8 element 450; and Table 1 at p. 34).

VI. Grounds of Rejection to be Reviewed on Appeal (37 C.F.R. §41.37(c)(1)(vi))

A. Whether claims 1-4, 7-9, 13, 16, 18-19, 20-23 and 25-26 are unpatentable under 35 U.S.C. §102(e) over Hirata, U.S. Patent No. 5,212,631 (“Hirata”); and

B. Whether claim 5-6, 10-12, 14-15, 17 and 24 are unpatentable under 35 U.S.C. §103(a) over Hirata.

VII. Argument (37 C.F.R. §41.37(c)(1)(vii))

A. Rejection of Claims 1-4, 7-9, 13, 16, 18-19, 20-23, and 25-26 Under 35 U.S.C. §102(e)

Claims 1-4, 7-9, 13, 16, 18-19, 20-23, and 25-26 stand rejected under 35 U.S.C. §102(e) as being unpatentable over Hirata. Reversal of this rejection is respectfully requested for at least the following reasons. Hirata does not disclose *each* and *every* limitation of the claims. In particular, Hirata does not disclose a token having a *schema*.

A single prior art reference anticipates a patent claim if “*each* and *every* limitation set forth in the patent claim” is disclosed either expressly or inherently. (*Trintec Industries, Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 1295, 63 U.S.P.Q.2d 1597, 1599 (Fed. Cir. 2002) (citing to *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1052-53 (Fed. Cir. 1987)) (emphasis added). Moreover, “[t]he *identical* invention must be shown in as *complete* detail as is contained in the patent claim.” (*Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989) (citing *Jamesbury Corp. v. Litton Industrial Products, Inc.*, 756 F.2d 1556, 1560, 225 U.S.P.Q. 253, 257 (Fed. Cir. 1985); and *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548, 220 U.S.P.Q. 193, 198 (Fed. Cir. 1983))) (emphasis added).

All the subject claims recite the limitation a token having a *schema*. The token schema is a *data structure*. (See e.g., Application at p. 30, lines 27-30). The token having a *schema* is adapted to be transmitted, for example, to a recording system to program the system to record an audio and/or visual program. (See e.g., Application at p. 4, lines 5-15). The token having a *schema* may be transmitted, for example, by attaching the token to an e-mail. (See *Id.*). Figure 8 and Table 1 of the subject patent application are schematic illustrations of exemplary token *schemas*. (See Application at Fig. 8 and Table 1 at p. 34). The token *schema* is defined in the subject application as a *data structure* that contains a *plurality* of fields for holding *different types* of data. (See e.g., Application at p. 30, lines 27-30). The *different types* of data may include, for example, a global unique identifier (“GUID”), a program GUID, billing information, program characteristics, program descriptions, images, video clips, authentication elements, passwords, encryption elements, personal video recorder (“PVR”) GUID, and account

information. (See Application at pp. 31-33). Thus, the token *schema* with a *plurality* of fields for holding *different types* of data provides for a variety of functionality such as encryption, password protection, tracking, automated billing, and can even provide video clips to allow a user to preview the selected program.

Hirata does not disclose a token having a *schema*. Hirata discloses a system for programming a video deck *via* an e-mail containing a control command character string. (See e.g., Hirata at col. 1, lines 49-62; and col. 6, lines 21-25). In the system of Hirata, a user desiring to program the video deck transmits an e-mail containing the control command character string through the internet to a CPU. The CPU extracts the control command and programs the video deck. Thus, Hirata discloses an e-mail that contains only *one type* of data (a control command) and that facilitates performing only *one* type of function (programming a device).

The tokens having a schema of the subject claims are distinguishable from the e-mails of Hirata in terms of the data structure, variety of data content, and degree of functionality. The tokens having a schema are distinguishable in terms of both structure and content because the token schema are *data structures* have a *plurality* of fields for holding *different types* of data. The e-mails of Hirata do not contain data structures and contain only *one type* of data – a control command. These control commands are capable of facilitating only *one* type of function – programming a device. Because the tokens having a schema contain *different types* of data, these tokens facilitate performing *more than one* type of function and therefore have greater functionality than the e-mails of Hirata.

In the Final Office Action, the Examiner rejected the claims arguing that Hirata discloses “passing parameters within the e-mail for recording a video program.” (See Final Office Action dated May 10, 2004 at p. 3). However, the Examiner only addressed the *functional* aspects of the token having a schema and failed to address the *structural* aspects. The claim limitation *schema* is a *structural* limitation. A token schema is *structurally* different from the e-mails of Hirata because it is a *data structure* with a *plurality* of fields for holding *different types* of data. Hirata merely discloses an e-mail containing *one* type of data - a command control character string. A command control character string is not a data structure and does not have a plurality of fields for holding

different types of data. It is merely a character string, not a *schema*. Thus, the token having a *schema* is structurally distinguishable from the e-mails described in Hirata. Moreover, as discussed above, the e-mails of Hirata are limited to facilitating *only one* type of function, whereas a token having a schema holding *different types* of data can facilitate *more than one* type of function. Therefore, the token having a schema has greater functionality compared to the e-mail of Hirata.

In the Final Office Action, the Examiner argues that Hirata discloses a token as defined by Webster's Dictionary and the Microsoft Computer Dictionary, but concedes in the Advisory Action that the Microsoft Computer Dictionary definition does not correspond to the definition of a token in the subject patent application. (See Final Office Action at p. 2 and Advisory Action dated July 14, 2004 at p. 2). However, as discussed in the Reply to the Final Office Action and reiterated above, Hirata does not disclose a token having a *schema* as that term is defined in the subject application (*i.e.*, a *data structure* with a *plurality* of fields for holding *different types* of data). (See Reply to Final Office Action at p. 3).

In view of at least the reasons stated above, the prior art fails to disclose *each* and *every* claim limitation. In particular, a token having a *schema* is not disclosed, either expressly or inherently, in Hirata. Therefore, the rejection of independent claims 1, 8, 16, 20, and 22, and claims that depend there from, should be withdrawn.

B. Rejection of Claims 5-6, 10-12, 14-15, 17 and 24 Under 35 U.S.C. §103(a)

Claims 5-6, 10-12, 14-15, 17 and 24 stand rejected under 35 U.S.C. §103(a) because the Examiner contends that these claims are unpatentable over Hirata. Reversal of this rejection is respectfully requested for at least the following reasons. The cited prior art does not teach or suggest the claimed invention as a *whole*. (See *Graham v. John Deere Co.*, 383 U.S. 1, 3 (1966); *see also e.g.*, *In re Dembicza*k, 175 F.3d 994, 998, 50 U.S.P.Q. 1614, 1616 (Fed. Cir. 1999)). Claims 5-6, 10-12, 14-15, 17 and 24 all depend from one of the independent claims. By virtue of this dependency, these claims contain all of the limitations of the independent claims. All of the independent claims are allowable for at least the reasons stated in Section VII(A) *supra*. Hirata does not disclose

each and *every* limitation of the claims. In particular, Hirata does not disclose a token having a *schema*. Accordingly, claims 5-6, 10-12, 14-15, 17 and 24 are allowable for at least the same reasons. Hence, this rejection should be withdrawn.

C. Conclusion

For at least the above reasons, the claims currently under consideration are believed to be patentable over the cited references. Accordingly, it is respectfully requested that the rejections of claims 1-26 be reversed.

If any additional fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063.

Respectfully submitted,
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VIII. Claims Appendix (37 C.F.R. §41.37(c)(1)(viii))

1. A system for representing at least one of an audio and visual program, comprising:
 - a token having a schema that identifies a corresponding program so that a recording system receiving the token is programmable to record the program based on the token, the token being transportable between at least two computers.
2. The system of claim 1, wherein the token is operatively associated with a message component that is transportable between the at least two computers.
3. The system of claim 2, wherein the message component is a text email message.
4. The system of claim 1, wherein the predefined schema includes elements identifying sufficient characteristics of the corresponding program so that the recording system is programmable to record the corresponding program in response to receiving the token.
5. The system of claim 4, wherein the token schema includes a universal program identifier for the corresponding program.
6. The system of claim 5, wherein the token schema includes a plurality of program characteristics that identify different aspects of the corresponding program.
7. The system of claim 1, wherein the token is transmittable as a component associated with a message sent from a first computer to a second computer, the first computer not being directly connected to the second computer.
8. An electronic signal adapted to be transmitted between at least two computers comprising a message component having an associated token, the token having a schema

that includes program criteria representing a corresponding program of at least one of an audio and visual program.

9. The signal of claim 8, wherein the message component further includes a text component to which the token is operatively associated.

10. The signal of claim 9, wherein the token is an attachment to the text component of the message.

11. The signal of claim 8, wherein the signal is provided from a server computer to a client computer, the message originating at a different computer and addressed to an address associated with the client computer.

12. The signal of claim 11, wherein the message is a text email message.

13. The signal of claim 8, wherein the schema includes elements identifying sufficient characteristics of the corresponding program so that a recording system receiving the signal is programmable to record the corresponding program based on the token.

14. The signal of claim 13, wherein the token schema includes a universal program identifier for the corresponding program.

15. The system of claim 14, wherein the token schema includes a plurality of program characteristics that identify different aspects of the corresponding program.

16. A computer-readable medium having stored thereon computer-executable components, comprising:

a first component containing data representing a text email message; and
style="padding-left: 40px;">a second component operatively associated with the first component, the second component including a token having a schema that includes program criteria representing a corresponding program of at least one of an audio and visual program.

17. The computer-readable medium of claim 16, wherein the token is an attachment to the text email message.
18. The computer readable medium of claim 16 having further computer-executable components for addressing the email message to an address associated with a remote computer and sending the message and associated token to the remote computer.
19. The computer readable medium of claim 16, wherein the program criteria of the token further includes sufficient characteristics of the corresponding program so that a recording system receiving the token is programmable to record the corresponding program based on the token.
20. A system for facilitating programming of an associated device comprising:
 - means for extracting a token from a message received from another computer; and
 - means for providing a token having a schema that includes program criteria for identifying a corresponding program of at least one of an audio and visual program.
21. The system of claim 20, wherein the program criteria includes elements identifying sufficient characteristics of the corresponding program so that a recording system receiving the token is programmable to record the corresponding program based on the token.
22. A method for facilitating programming an recording system, the method comprising:
 - receiving a message having at least one associated token; and
 - extracting a token from the message, the token having a schema that includes program criteria representing a selected broadcast program.

23. The method of claim 22, further including programming operation of the recording system to record the selected broadcast program based on the program criteria of the extracted token.

24. The method of claim 23, wherein the message is text email message, the token being received as an attachment to the text email message.

25. The method of claim 22, further including addressing the message to an address associated with a remote computer and sending to the remote computer the message and the associated token.

26. The method of claim 22, wherein the program criteria of the token further includes sufficient characteristics of the corresponding program so that a recording system receiving the token is programmable to record the corresponding program based on the token.

IX. Evidence Appendix (37 C.F.R. §41.37(c)(1)(ix))

None.

X. Related Proceedings Appendix (37 C.F.R. §41.37(c)(1)(x))

None.